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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,156	02/08/2001	Ursula Murschall	00/053 MFE	4234

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,156

Applicant(s)

MURSCHALL ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 1/6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment, mailed October 27, 2003.

Claim 8 was amended and claims 17-20 were added rendering claims 1-20 pending with claims 12-15 held to a non-elected invention.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In instant claims 8, 17-18 and 20, the phrase, "...in the absence of heat stabilizers" is not supported by the specification.' Additionally, in claim 19, the phrase, "lower than the luminous transmittance of a comparable film formed from said crystallizable thermoplastic having the same thickness as said film and lower longitudinal orientation than said film" is not supported by the instant specification.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 and 9-11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) as previously stated in the Office Action submitted on July 15, 2003.

Claim Rejections – 35 USC § 103(a)

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) as previously stated in the Office Action submitted on July 15, 2003.

NONSTATUTORY DOUBLE PATENTING

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

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USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of Murschall et al. (U.S. 6,521,351) as previously stated in the Office Action submitted on July 15, 2003.

9. Claim 16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Arguments to rejection of claim 16 made under 35 U.S.C. 112, first paragraph, has been withdrawn due to clarification made by Applicant. Examiner acknowledges Applicant's willingness to file a terminal disclaimer under US 6,521,351 to Murschall et al. upon indication of allowable subject matter.

Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) have been considered but are unpersuasive. Applicant argues Kim either alone or in combination with the art of

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record, does not teach the claimed invention, which recites a crystallizable thermoplastic consisting essentially of polyester because polyesters are most certainly not polyolefins. Based upon Applicant's disclosure on the differences between the polyolefin and polyester resins of Kim, Examiner acknowledges the two resins are different in this reference. Instant claim 1 discloses a opaque, white film, wherein the film comprises a crystallizable thermoplastic, barium sulfate, and at least one optical brightener, wherein said crystallizable thermoplastic consists essentially of polyester. Kim et al. discloses a white film (base layer) comprising polyethylene terephthalate (crystallizable thermoplastic), barium sulfate (column 2, lines 3-9), and bisbenzazole (optical brightener) (column 5, lines 13-22). The film of Kim comprises 99 parts by weight of polyester resin and 1 part by weight of polyolefin resin. 1 part by weight of polyolefin will not materially affect the opacity of Kim's film. Furthermore, Applicant's preamble of claim 1 states the film "comprises" a crystallizable thermoplastic and then claims the crystallizable thermoplastic consists essentially of polyester. The comprising language renders the film material to be inclusive of additives that do not materially affect the characteristic of the film, such as 1 part by weight of polyolefin resin. Applicant further argues Kim does not teach or suggest the claimed combination of crystallizable thermoplastic, barium sulfate and optical brightener which translate into films whose luminous transmittance is reduced when the longitudinal stretch ratio is increased as exhibited by comparable films having lower longitudinal orientation. Applicant's argument is of little merit because it is based on new matter. In instant claim 19, the phrase,

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"lower than the luminous transmittance of a comparable film formed from said crystallizable thermoplastic having the same thickness as said film and lower longitudinal orientation than said film' is not supported by the instant specification. Applicant argues Kim does not teach films exhibiting the mechanical properties of the films invention. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., mechanical properties) are not recited in the rejected claim(s) 1-7 and 9-11, which Kim is deemed obvious over. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner acknowledges Kim et al. does not disclose the film being recycled. Applicant argues Kim does not disclose a thickness of instant claims 1 and 10. Such thicknesses are properties which can easily be determined by one of ordinary skill in the art. With regard to the limitation of the thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. Thickness is optimizable as it directly affects the transparency and reflectiveness of the film.

Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. 4,933,043) in view of von Meer (U.S. 4,384,040) have been considered but are unpersuasive. Applicant argues Von Meer does

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not cure the deficiencies of Kim. Because Kim has been maintained, the rejection of Kim in view of Von Meer is maintained as well. In response to applicant's argument that Von Meer does not teach the recited film thickness or the luminous transmittance of the film, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The purpose for the Von Meer reference is to show the conventionality of blue dye in films. Kim in view of Yamazaki is withdrawn due to Applicant's argument as the film of Yamazaki being directed to olefinic films.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

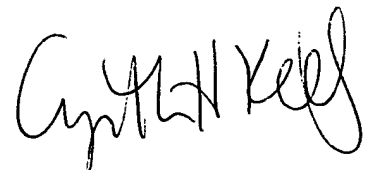
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
Art Unit 1774



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